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09/496,065	02/01/2000	N. Asokan	SZ998-041	5668

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EXAMINER
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SIMITOSKI, MICHAEL J

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 11/07/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/496,065

Applicant(s)

ASOKAN ET AL.

Examiner

Michael J Simitoski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☒ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 February 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or

**NORMAN M. WRIGHT**  
PRIMARY EXAMINER

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

1. The IDS of 2/01/2000 has been considered.
2. Claims 1-30 are pending.

### ***Drawings***

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "4" has been used to designate both "table" on page 13, line 2 of the specification and "network" on page 7, line 7 of the detailed description.
4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because drawings 2-5 should be labeled such as Fig. #.
5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the partially output message of claims 23 and 24 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Specification***

6. The disclosure is objected to because of the following informalities (some words are underlined for clarification):

On page 4, 5<sup>th</sup> paragraph, “to the terminal but eh” should be replaced with “to the terminal by the”,

On page 5, 2<sup>nd</sup> paragraph, line 8, “For authentication, any know” should be replaced with “For authentication, any known”,

On page 7, 1<sup>st</sup> paragraph of the DETAILED DESCRIPTION, line 4, “via which is” should be replaced with “via which”,

On page 11, 2<sup>nd</sup> paragraph, the label “Section 2.1” is not in specification,

On page 12, 1<sup>st</sup> paragraph, “compromises” should be “comprise”,

On page 13, 2<sup>nd</sup> paragraph, in the sentence “The server is furthermore has”, “is” should be removed,

On page 14, 1<sup>st</sup> paragraph, the label “Section 2.1” is not in specification.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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8. Claims 23 and 24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specifications give no example of a partially outputted message of claims 23 and 24, either by the terminal or the device.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 3, 4, 6, 7, 9-11 and 27-30 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,475,756 to Merritt.

Regarding claims 1, 27 and 30, Merritt discloses a terminal that can communicate with a personal device/card (see Fig. 1). The terminal is connected to a server/host (see Fig. 1) and the terminal/ATM authenticates itself with the server/host (see Fig. 3, element 315). Authentication information is contained on the card (see col. 3, lines 64-67 and col. 4, lines 1-11) to be read by the terminal/ATM (see Fig. 3). Merritt discloses a terminal displaying an authenticity output message/PSP in response to authentication (see Fig. 5 and col. 3, lines 20-48).

Regarding claim 3, Merritt discloses requesting user authentication information/PIN and verifying the authentication information/PIN with predefined values (see col. 1, lines 31-46).

Regarding claim 4, Merritt discloses a message/PSP taking many forms, such as a still image, a sequence of images, a video or an audio clip (see col. 4, lines 16-23).

Regarding claim 6, Merritt discloses a terminal with a device input component/card reader (see Fig. 1, element 14), communication component (see Fig. 1, element 9) for receiving authenticity output message/PSP (see Fig. 3, element 370) and a message output component/presentation module (see Fig. 1, element 22 and col. 3, lines 40-45).

Regarding claim 7, Merritt discloses a user interface component/keyboard (see Fig. 1, element 21).

Regarding claims 9 and 11, Merritt discloses a server/host (Fig. 1, element 2), a communications component (see Fig. 1, element 9), a receiver means (see Fig. 3, elements 310 and 360), an authenticity component to verify the terminal's authenticity (see Fig. 1, elements 4 and 8, Fig. 3, element 315 and col. 2, lines 10-14) and a message generation component (see Fig. 1, element 3) and a storage location (see Fig. 1, element 3) for storing a user-specific authenticity output message/PSP (see col. 4, lines 11-20).

Regarding claim 10, Merritt discloses the host and the terminal negotiating a session key (see col. 6, lines 54-62).

Regarding claim 28, Merritt discloses accessing a database/lookup table that stores user-specific messages/PSPs (see col. 7, lines 1-10).

Regarding claim 29, Merritt discloses exchanging messages (see Fig. 3, elements 380 and 390).

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Merritt in view of U.S. Patent 5,748,737 to Daggar. Merritt discloses a smart card system, as described above, but lacks authenticating the card to the terminal. Daggar teaches that establishing card authenticity is needed to make sure data from a card is genuine and to prevent indiscriminate card reproduction (see col. 7, lines 13-19). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to authenticate Merritt's card to the terminal to ensure data integrity. One of ordinary skill in the art would have been motivated to perform such a modification to ensure the data from the card is genuine and to prevent indiscriminate card reproduction, as taught by Daggar.

13. Claims 5 and 8, are rejected under 35 U.S.C. 103(a) as being unpatentable over Merritt, as applied to claims 1 and 6 above, in view of U.S. Patent 4,386,416 to Giltner et al. (Giltner). Merritt discloses an authentication system, as described above, but lacks storing a lookup table. However, Giltner teaches that reducing the amount of data to be transmitted will reduce

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transmission time (see col. 1, lines 44-48). Giltner further teaches that by transmitting addressing codes to a stored library, rather than transmitting the data in the library that the codes represent, can significantly reduce the data to be transmitted because the address code is much smaller than the data it represents (see col. 3, lines 14-32). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to store the authenticity output message in a lookup table in the terminal to reduce transmission time. One of ordinary skill in the art would have been motivated to perform such a modification to reduce the amount of data transmitted and hence reduce transmission time, as taught by Giltner.

14. Claims 12-19, 21, 22 and 26, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Merritt in view of U.S. Patent 5,737,423 to Manduley.

Regarding claim 12, Merritt discloses a server authenticating a terminal and establishing a trusted connection (see Fig. 3, element 315), a server authenticating itself (see Fig. 4), establishing a second trusted connection (see Fig. 5, element 509) and the server providing an authenticity message to the terminal (see Fig. 5, elements 511 and 513). Merritt lacks providing a terminal authenticity message to the device. Manduley teaches that by exchanging a set of messages between a user and a smart card (see col. 2, lines 7-23), one can assure that the user is actually in possession of the card (see col. 1, lines 41-56). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the smart card of Merritt's system with an authenticity message so the server is ensured the user is in possession of the smart card and receiving the messages. One of ordinary skill in the art would

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have been motivated to perform such a modification to guarantee the server that the person receiving a message is the person actually in possession of the card, as taught by Manduley.

Regarding claim 13, Merritt discloses communicating a message to a user (see Fig. 5, element 515).

Regarding claims 14, 17, 19 and 21, Merritt discloses a smart card system, as described above, but lacks displaying messages on the card. Manduley teaches that by exchanging a set of messages between a user and a smart card (see col. 2, lines 7-23), one can assure that the user is actually in possession of the card (see col. 1, lines 41-56). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a visual display in Merritt's smart card for the purposes of exchanging messages between the user and the card. One of ordinary skill in the art would have been motivated to perform such a modification to ensure that the person responding to a message is actually in possession of the card, as taught by Manduley.

Regarding claim 15, Merritt discloses a terminal displaying a message (see col. 3, lines 40-45).

Regarding claim 16, Merritt discloses accessing a database/lookup table that stores user-specific messages/PSPs (see col. 7, lines 1-10).

Regarding claim 18, Merritt discloses authentication information contained on the card (see col. 3, lines 64-67 and col. 4, lines 1-11) to be read by the terminal/ATM (see Fig. 3). Merritt discloses a terminal displaying an authenticity output message/PSP in response to authentication (see Fig. 5 and col. 3, lines 20-48).

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Regarding claim 22, Merritt discloses a message/PSP taking many forms, such as a still image, a sequence of images, a video or an audio clip (see col. 4, lines 16-23).

Regarding claim 26, Merritt discloses authenticating a user (see Fig. 3, element 390).

15. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Merritt in view of Manduley, as applied to claim 12 above, in further view of U.S. Patent 4,868,376 to Lessin et al. (Lessin). Merritt discloses a smart card system, as described above, but lacks the card requesting the user authenticate himself. Lessin teaches that by requiring the user enter a PIN, a card can prevent unauthorized access to data (see col. 4, lines 7-11 and col. 8, lines 27-41). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Merritt's smart card system to request the user authenticate himself to prevent unauthorized access. One of ordinary skill in the art would have been motivated to perform such a modification to prevent unauthorized access to data on the card, as taught by Lessin.

16. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Merritt in view of Manduley, as applied to claim 12 above, in view of U.S. Patent 5,748,737 to Daggar. Merritt discloses a smart card system, as described above, but lacks authenticating the card to the server. Daggar teaches that establishing card authenticity is needed to make sure data from a card is genuine and to prevent indiscriminate card reproduction (see col. 7, lines 13-19). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have Merritt's server authenticate the card to ensure data integrity. One of ordinary skill

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in the art would have been motivated to perform such a modification to ensure the data from the card is genuine and to prevent indiscriminate card reproduction, as taught by Daggar.

***Conclusion***

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Simitoski whose telephone number is (703)305-8191. The examiner can normally be reached on Monday - Thursday, 8:00 a.m. - 5:30 p.m.. The examiner can also be reached on alternate Fridays from 8:00 a.m. - 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on (703)308-4789.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, DC 20231

**Or faxed to:**

(703)746-7239 (for formal communications intended for entry)

**Or:**

(703)746-7240 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA 22202, Fourth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9000.



MJS  
30 October 2003



11/03/03  
NORMAN M. WRIGHT  
PRIMARY EXAMINER